

REMARKS

Claims 1-18 are pending in this application.

Claims 1-10 and 12-18 are rejected.

Claim 11 is objected to.

Provisional Double Patenting Rejection

Claims 1, 6-7 and 17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 11-12 and 17 of compenig Application No. 09/734625. Applicants enclose a terminal disclaimer to overcome the above rejection.

The Applicants respectfully requests reconsideration of the arguments below by the Examiner although submitted after Final Rejection. The intent of the comments below is to focus and simplify the issues for reconsideration.

35 USC § 103(a)

Claims 1-10 and 12-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laridon et al., US 4282309.

Examiner continues to maintain that Laridon clearly teaches that R₅ is a hydrogen atom and R₄ is an alkaryl group, that although not exemplified, one of ordinary skill in the art can readily envision the use of hydrogen and alkaryl as suitable substituents making the instant invention obvious over the cited prior art.

Applicants disagree. Laridon does not teach any single compound wherein R₅ is hydrogen specifically. The description of such compounds is only encompassed by the generic definition of the formula of Laridon. Laridon further does not specifically disclose any single compound wherein the aryl is substituted (see the specific examples column 3, compounds A-E).

“Disclosure” means, that a compound has to be taught concretely – not only generically. Accordingly, Laridon’s disclosure is restricted to compounds wherein $R_5 \neq$ hydrogen and wherein the aryl R_4 is unsubstituted.

The fact, that Laridon specifically discloses compounds avoiding the hydrogen R_5 , teaches away from using such compounds, and that Laridon did not recognize the advantages of R_5 =hydrogen and R_4 as substituted aryl. Further Laridon clearly states that the compounds A-E are particularly useful (see col. 3, lines 15-16). A further indication that an improvement with compounds having another substitution pattern is not to be expected in an obvious manner.

Furthermore, Laridon clearly states that compounds with at least one of R_4 and R_5 being an acyl group are preferred (see column 3, lines 2-3). Accordingly, Applicant’s testing of a corresponding acyl-substituted compound according to Laridon versus a non-acyl compound according to the present invention ($Ar_1 \neq$ aroyl in the present claims) is correct. Further, while Laridon’s most preferred compounds (col. 3, A-E) have no substituents on the aroyl groups R_4 , according to Applicant’s claims, the aryl in the corresponding position of the molecule (Ar_1) must be substituted. Thus, Applicant was right in comparing compounds with a substituent at the Ar_1 to Laridon’s preferred unsubstituted one.

In line with Laridon’s concrete disclosure, Applicants in the tests compared the closest compound actually taught by Laridon.

As already explained in our previous letter (see our letter dated August 22, 2003) according to *ex parte Westphal*, only such compounds of the prior art, which are actually taught in the prior art must be subject in a comparative test. In this case, Applicants claimed a tert-butyl-substituted compound, while the prior art generically taught C_1 - C_8 alkyl. The Examiner alleges that tests comparing the claimed tert-butyl compound with the corresponding isopropyl-substituted compound, which was not exemplified in the prior art, although covered by the generic disclosure should be compared. The court held that Applicants did NOT have to compare said compound with the claimed one: “*Applicants were justified in testing closest compounds actually taught in reference, rather than compounds not exemplified*” (See 223 USPQ 633, left column).

Thus, the Examiner’s request in the present case, to test compounds of Laridon which are only subject to a generic claim and NOT specifically disclosed is unjustified.

To summarize:

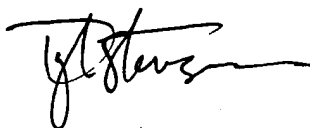
- Laridon does not specifically disclose compounds with $R_5 = H$, or compounds with a substituted aryl group R_4 .
- Laridon gives clear indications of preferred compounds, which preferences clearly teach away from the substitution pattern as claimed in the claims of the present invention. The person skilled in the art, based on the preferences given by Laridon would never obviously expect an improvement as shown in our comparative test.
- According to case law the request to compare a compound not actually taught in the prior art is unjustified.

Reconsideration and withdrawal of the rejection of claims 1-18 under 35 U.S.C. § 103 (a) is requested in light of the arguments above.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1-18 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



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